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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/918,874	07/30/2001	Seth Marder	21182-7067	3252

7590 11/04/2003

Patricia Coleman James
McCutchen, Doyle, Brown & Enersen, LLP
Suite 1800
Three Embarcadero Center
San Francisco, CA 94111

EXAMINER

METZMAIER, DANIEL S

ART UNIT	PAPER NUMBER
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1712

DATE MAILED: 11/04/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,874

Applicant(s)

MARDER ETAL.

Examiner

LOVERING

Group Art Unit

1712

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Status

- ☒ Responsive to communication(s) filed on JULY 30 & NOV. 7, 2001; APR. 24, 2002; AND APR. 9, 2003
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

- ☒ Claim(s) 3-7, 13 AND 14 is/are pending in the application.
- Of the above claim(s) _____ is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 3-7, 13 AND 14 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
 - ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been received.
 - ☐ received in Application No. (Series Code/Serial Number) _____
 - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

*Certified copies not received: _____

Attachment(s)

- ☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 4
- ☐ Interview Summary, PTO-413
- ☒ Notice of Reference(s) Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other _____

Office Action Summary

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1. Claims 3-7, 13 and 14 are generic to a plurality of disclosed patentably distinct species comprising a) compounds of Examples 1-5, 8-11, 15-21, 25-27, 31-42, 44, 45, 47-50, 52-58, 60-63 and 69-75; b) compound of Examples 6 and 7; c) compound of Examples 12 and 13; d) compound of Example 14; e) compounds of Examples 22-24 ⁿad 43; f) compounds of Examples 28-30, 77 and 78; g) compound of Example 46; h) compounds of Examples 51 and 79; i) compound of Example 59; and j) compound of Examples 64-68 and 76. Applicants are required under 35 U.S.C. § 121 to elect a single disclosed species, even though this requirement is traversed.

Should applicants traverse on the ground that the species are not patentably distinct, applicants should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. § 103 of the other invention.

During a telephone conversation with Mr. David Maher on April 21, 2003, a provisional election was made without traverse of species a), compounds of Examples 1-5, 8-11, 15-21, 25-27, 31-42, 44, 45, 47-50, 52-58, 60-63 and 69-75.

2. Applicants' designation of this application as a division of 08/965,945 (now U.S. Patent No. 6,267,913) is objected to, their election of a species herein different from that elected in the parent case notwithstanding. The '913 patent has method claims 2 and 3 (noting also composition claim 1) which method claims read on or at least overlap the claims of this

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application. Applicants are required to correct the sentence inserted on page 1, line 16 of the specification by the pre-amendment filed April 24, 2002 to state that this application is a continuation of the parent.

3. The non-statutory double patenting rejection, whether of the obvious-type or non-obvious-type, is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent. *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); *In re Van Ornam*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); and *In re Goodman*, 29 USPQ 2d 2010 (Fed. Cir. 1993).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321 (b) and (c) may be used to overcome an actual or provisional rejection based on a non-statutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.78 (d).

Effective January 1, 1994, a registered attorney or agent of record may sign a Terminal Disclaimer. A Terminal Disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

4. Claims 3-7, 13 and 14 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 2 and 3, noting also claim 1 as to the B₁πD₂ compounds of U.S. Patent No. 6,267,913. Although the conflicting claims are not identical, they are not patentably distinct from each other because the instant claims at least overlap the claims of the '913 patent.

5. The following is a quotation of the second paragraph of 35 U.S.C. § 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regard as their invention.

6. Claims 4-7, 13 and 14 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicants regard as the invention.

a) Claims 4-7, 13 and 14 recite Markush groups which are not considered proper for the reasons that they are indefinite as to scope and incomplete as to their memberships in using "or" instead of --and-- between the penultimate^{and} last member^s; and in not reciting --the group consisting of-- after "selected from"; and

b) claims 6, 13 and 14 are indefinite, incomplete and confusing in reciting an inverted "A" and a backwards "E" instead of the Greek letters α and β .

7. The remaining references listed on the attached Form PTO-1449 (three pages) and Form PTO-892 are cumulative to the reference applied herein, and/or further show the state of the art.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Lovering whose telephone number is (703) 308-0443. The examiner can normally be reached on Mon.-Fri. from 7:30 A.M. to 4:00 P.M.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Dawson, can be reached on (703) 308-2340. The fax phone number for this Group is (703) 872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0661.

R. Lovering:cdc
April 23, 2003

RICHARD D. LOVERING
PRIMARY EXAMINER
GROUP ~~1200~~ 1700